Docket No.: PA-0020 US

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, Washington, D.C. 20231 on 1 August 2001.
Printed: _____.
By: Katherine Stofer.

#17
Plunkett
8/10/01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: SORNASSE, et al.

Title: GENES REGULATED BY HUMAN CYTOKINES

Serial No.:	09/435,247	Filing Date:	5th November, 1999
Examiner:	WOODWARD, M.	Group Art Unit:	1631

Commissioner for Patents
Washington, D.C. 20231

RESPONSE TO RESTRICTION REQUIREMENT

Sir:

This communication is in response to the Restriction Requirement mailed 9th July, 2001, Paper Number 6, in the above-referenced application. This response is timely filed.

Claims 1-20 were originally filed. In the Office Action, the Examiner requested Applicants to elect claims corresponding to one of the following inventions:

Group I	Claims 1, 6-7, and 18-20	drawn to a set of polynucleotides and methods of use (classified in class 435, subclass DIG 37)
Group II	Claims 2-5 and 11-13	drawn to polynucleotides and methods of use (classified in class 536, subclass 23.1)
Group III	Claims 8 and 9	drawn to methods of screening a compound with polynucleotide (classified in class 435, subclass DIG 17)
Group IV	Claim 10	drawn to a method of purifying ligands (classified in class 435, subclass 6)
Group V	Claim 14	drawn to polypeptide (classified in class 530, subclass 350)
Group VI	Claims 15-16	drawn to a method of screening with polypeptide binding (classified in class 435, subclass DIG 15)
Group VII	Claim 17	drawn to methods of purifying ligands (classified in class 435, subclass 7.1)

In response to the Restriction Requirement, Applicants elect Group I (claims 1, 6-7, and 18-20), with traverse. Applicants submit that the invention encompassed by the claims of Groups V (drawn to polypeptide encoded by a polynucleotide) could be examined at the same time as the inventions encompassed by the claims of Group I (drawn to polynucleotide).

For example, a search of the prior art to determine the novelty of the nucleic acid molecules of the invention would provide information regarding the novelty of the polypeptide encoded by the polynucleotide of the invention. Accordingly, Applicants submit that examination of claims 1, 6-7, 14, and 18-20 would not pose undue burden.

The Examiner is respectfully reminded that, upon allowance of the claims to the above products, the process for making and using same, i.e., the claims of Group III, must be rejoined. See the Commissioner's Notice in the Official Gazette of March 26, 1996, entitled "Guidance on Treatment of Product and Process Claims in light of *In re* Ochiai, *In re* Brouwer and 35 U.S.C. § 103(b)" which sets forth the rules, upon allowance of product claims, for rejoinder of process claims covering the same scope of products. Thus, Applicants respectfully request reconsideration of the Restriction Requirement and examination of claims 1, 6-9, 14, and 18-20.

The Examiner stated that each Group reads on patentably distinct sequences. The Examiner then stated that each sequence is patentably distinct because they are unrelated sequences, and a further restriction is applied to each Group. The Examiner stated that for an elected Group drawn to amino acid sequences, the Applicants must elect a single amino acid sequence The Examiner further stated that for an elected Group drawn to nucleic acid sequences, the Applicants must elect a single nucleic acid sequence.

The Examiner stated that in regard to Invention I, the set of polynucleotides, a single sequence must be elected from the recited 1-516. The Examiner stated that if that sequence is novel, then the combination of sequences is also novel. Similarly, a single sequence must be elected for the Inventions using the set of polynucleotides in other methods.

The Examiner stated that in regard to Inventions II and V, a single sequence must be elected from 1-243 for nucleic acids (Invention II), and from a polypeptide encoded by 1-243 for Invention V. Similarly, a single sequence must be elected for the Inventions using an isolated polypeptide or isolated polynucleotide.

The Examiner stated that nucleotide unrelated sequences encoding different proteins are structurally distinct chemical compounds and are unrelated to one another. The Examiner stated that

these sequences are thus deemed to normally constitute independent and distinct inventions within the meaning of 35 U.S.C. § 121. The Examiner stated that, absent evidence to the contrary, each such nucleotide sequence is presumed to represent an independent and distinct invention, subject to a restriction requirement pursuant to 35 U.S.C. § 121 and 37 C.F.R. § 1.141 et seq..

The Examiner stated that in the present state of Office resources, the search and examination of more than one sequence is deemed to impose an undue burden upon the office and strained office resources, therefore, Applicants must elect a single sequence to be searched. In addition to the specifically selected sequences, those sequences which are patentably indistinct from the selected sequences (*sic*) will also be examined. Furthermore, the Examiner stated, nucleotide sequences encoding the same protein are not considered to be independent and distinct inventions and will continue to be examined together.

The Examiner stated that because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicants respectfully traverse the Examiner's request that Applicants elect no more than one of the individual sequences for examination for the following reasons.

Applicants respectfully submit that claim 1 is drawn to a composition comprising a plurality of polynucleotide targets. Applicants note that the Examiner has described the invention of claim 1 as a "set" of polynucleotides. Applicants respectfully draw the Examiner's attention to the application at page 6, lines 11-15, where the term "plurality" is defined. Applicants submit that the term "plurality" is equivalent to the terms "group", "set", and "combination" and as such, conforms to EXAMPLES OF NUCLEOTIDE SEQUENCE CLAIMS set forth in MPEP 803.04:

> "(B) a combination of DNA fragments comprising SEQ ID Nos:1-1,000"

and

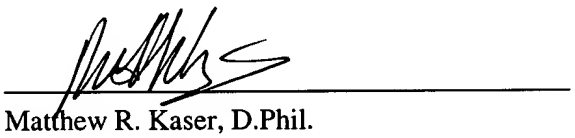
> "Applications claiming only a combination of nucleotide sequences, such as set forth in example (B), will generally not be subject to a restriction requirement. The presence of one novel and nonobvious sequence within the combination will render the entire combination allowable. The combination will be searched until one nucleotide sequence is found to be allowable. The order of searching will be chosen by the examiner to maximize the identification of an allowable sequence."
>
> (Underlining added) MPEP 803.04

Applicants respectfully request that the Examiner reconsider and withdraw the requirement for restriction. Nevertheless, Applicants provisionally elect the nucleic acid molecule of SEQ ID NO:219 for examination, with traverse.

This response is timely filed. However, if the USPTO determines that an additional fee is due, the Commissioner is hereby authorized to charge Incyte Genomics, Inc. Deposit Account No. **09-0108.** **This form is enclosed in duplicate.**

Respectfully submitted,
INCYTE GENOMICS, INC.

Date: 1st August 2001



Matthew R. Kaser, D.Phil.
Reg. No. 44,817

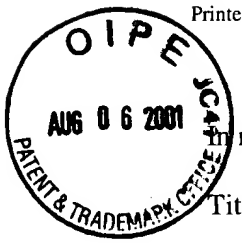
3160 Porter Drive
Palo Alto, California 94304
Phone: (650) 845-4596
Fax: (650) 849-8886

GAU 1631

Docket No.: PA-0020 US

RECEIVED
AUG 0 8 2001
TECH CENTER 1600/2900

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, Washington, D.C. 20231
on August 1, 2001
By: _____
Printed: Katherine Stofer



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Sornasse et al.

Title: GENES REGULATED BY HUMAN CYTOKINES

Serial No.: 09/435,247 Filing Date: November 05, 1999

Examiner: Woodward, M. Group Art Unit:1631

Commissioner for Patents
Washington, D.C. 20231

TRANSMITTAL FEE SHEET

Sir:

Transmitted herewith are the following for the above-identified application:

1. Return Receipt Postcard;
2. Transmittal Fee Sheet (1 pg., in duplicate); and
3. Response to Restriction Requirement (4 pp., in duplicate).

The fee has been calculated as shown below.

Claims	Claims After Amendment	-	Claims Previously Paid For	=	Present Extra	Other Than Small Entity Rate	Fee	Additional Fee(s)
Total Claims	20	-	20	=		$18		$ 0
Indep. Claims	2	-	3	=		$80		$ 0
__ First Presentation of Multiple Dependent Claim						+$270		$ 0
						TOTAL		$ 0

__X__ No additional fee is required.
_____ Fee for Request for Extension of Time (___ months) $_____
_____ Please charge Deposit Account No. 09-0108 the amount of $_____

The Commissioner is hereby authorized to charge any additional fees required under 37 CFR 1.16 and 1.17, or credit overpayment to Deposit Account No. **09-0108**. **A duplicate copy of this sheet is enclosed.**

Respectfully submitted,

INCYTE GENOMICS, INC.

Date: 1st August 2001

Matthew R. Kaser, D.Phil.
Reg. No. 44,817
Direct Dial Telephone: (650) 845-4596

3160 Porter Drive
Palo Alto, California 94304
Phone: (650) 855-0555
Fax: (650) 849-8886